



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,306	08/02/2001	Robert A. Badley	ISA-064.01	3887

63767 7590 01/17/2007
FOLEY HOAG, LLP
PATENT GROUP, (w/ISA)
155 SEAPORT BLVD.
BOSTON, MA 02210-2600

EXAMINER

VENCI, DAVID J

ART UNIT	PAPER NUMBER
----------	--------------

1641

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/920,306

Applicant(s)

BADLEY ET AL.

Examiner

David J. Venci

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 16, 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5, 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 6-10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/28/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION***Election/Restrictions***

Examiner acknowledges Applicants' election of Invention I, claims 1-13, in the reply filed May 22, 2006. In addition, Examiner acknowledges Applicants' election of the peptide species Xaa-Glu-Asp, claim 6, in the reply filed October 16, 2006. Applicants elect with traverse. Applicants argue that a simultaneous examination of Invention I and Invention III would not place an undue burden on us because "[a] search and examination of a DNA encoding a polypeptide would also necessarily entail a search and examination of the polypeptide sequence, and vice versa" (see Applicants' reply, filed May 22, 2006, paragraph bridging pp. 1-2, third sentence). In addition, Applicants appear to argue that Examiners' requirement for species election is improper because the requirement "improperly limits a clearly described chemical genus" (see Applicants' reply, filed October 16, 2006, paragraph bridging pp. 1-2, second sentence).

Applicants' arguments have been carefully considered but are not persuasive *at this time*. Examiner respectfully disagrees with Applicants' assertion that a search and examination of a DNA encoding a polypeptide would also necessarily entail a search and examination of the polypeptide sequence. Examiner posits that the only thing a DNA and its corresponding polypeptide *might* have in common is their arbitrarily assigned alphanumeric English name. Thorough examination of any compound inevitably implicates a little more than its name.

The requirement is still deemed proper and is therefore made FINAL.

Claims 14 and 15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected Inventions, there being no allowable generic or linking claim. Claims 3, 5, 11 and 12 are

Art Unit: 1641

withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species, there being no allowable generic or linking claim.

Currently, claims 1, 2, 4, 6-10 and 13 are under examination.

Oath/Declaration

The oath or declaration is missing. An oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

Art Unit: 1641

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 4, 6-10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2 and 6, the phrase "core binding region" is indefinite. The space defined by "core binding region" is not clear.

In claim 6:

The phrase "[a] purified peptide according to claim 1" is indefinite. Whether the phrase references "purified peptide mimotope" recited in claim 1 is not clear.

The recited elected species "Xaa-Glu-Asp" is indefinite. The identity of one or more objects referenced by "Xaa" is not clear.

In claim 7, the phrase "a purified peptide in accordance with claim 1" is indefinite. Whether the phrase references "purified peptide mimotope" recited in claim 1 is not clear.

Art Unit: 1641

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 7-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Buechler *et al.* (US 5,089,391).

Buechler *et al.* describe a peptide against an antibody (see e.g., col. 15, line 23, "anti-antibody antibodies") against estradiol (see col. 29, lines 7-8).

Art Unit: 1641

Conclusion

Notwithstanding issues of indefiniteness, claim 6 appear free of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Venci whose telephone number is 571-272-2879. The examiner can normally be reached on 08:00 - 16:30 (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David J Venci
Examiner
Art Unit 1641

djv



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600